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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDRE WAGNER, ANDREAS POTH,
BARE SAID, CHRISTOPH LUBBE,
HORST F. SCHAUDE, SILKE STORCH,
and TOBIAS BRANDL

Appeal 2011-010707
Application 11/811,229
Technology Center 3600

Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE DECISION

We AFFIRM.[1]

BACKGROUND

Appellants' invention relates to a tool for automatically executing relevant testing in an Application Platform (Spec., para. [01]).

Claim 1, reproduced below, is representative of the subject matter on appeal:

> 1. A computer-implemented method of automatically testing a changed object within an application platform and objects related to the changed object within the application platform, the method comprising:
>
> constructing, by a computer processor, a decision tree data structure identifying a hierarchy of relations among all objects within the application platform;
>
> storing, by the computer processor, the decision tree data structure in a component relation database;
>
> responsive to an indication that an object has been changed, accessing, by the computer processor, the component relation database to search the decision tree data structure for automatically identifying objects related to the changed object based on a criteria that is applied to the decision data structure;
>
> identifying, by the computer processor, a test plan associated with the changed object from a testing plan database;

[1] Our decision will refer to the Appellants' Appeal Brief ("App. Br.," filed January 13, 2011) and Reply Brief ("Reply Br.," filed May 23, 2011), and the Examiner's Answer ("Ans.," mailed April 1, 2011).

> identifying, by the computer processor, test plans associated with objects that had been determined to be related to the changed object from the testing plan database;
>
> retrieving, by the computer processor, the identified test plan associated with the changed object and the identified test plans associated with the related objects; and
>
> automatically performing, by the computer processor, the identified test plans for the changed object and objects related thereto.

THE REJECTION

The following rejection is before us for review:

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shei (US 5,703,708, iss. Dec. 30, 1997) in view of Jim (US 2002/0007298 A1, pub. Jan. 17, 2002) and further in view of Gopal (US 2008/0071844 A1, pub. Mar. 20, 2008).

ANALYSIS

Independent claim 1 and dependent claims 2-5

We are not persuaded that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) by Appellants' argument that the combination of Shei, Jim, and Gopal does not disclose or suggest "identifying objects related to the changed object based on a criteria that is applied to the decision data structure," as recited in claim 1 (App. Br. 5-6 and Reply Br. 2-3). Instead, we agree with and adopt the Examiner's response to Appellants' argument as set forth at pages 8-10 of the Answer.

We note that the Examiner acknowledges that Shei does not explicitly disclose the argued feature, and the Examiner relies on Jim and Gopal to cure the deficiency of Shei (Ans. 5-6). The Examiner thus cites Figures 2a and 2b and paragraphs [0042] and [0043] of Jim as disclosing a hierarchy of

business activities and tasks associated with business categories organized in a tree structure, i.e., a decision tree (Ans. 5), and cites paragraphs [0018], [0019], [0021], [0024], [0032], and [0033] of Gopal as disclosing "identifying objects related to the changed object based on a criteria" (Ans. 5-6).

Appellants argue that the tree structure in Jim is used to organize business files and not for any other purpose, e.g., to identify objects related to a changed object by applying criteria to the structure (App. Br. 5-6 and Reply Br. 3), and that Gopal does not disclose that "its meta data objects are related based on any tree let alone a decision tree" (App. Br. 6 and Reply Br. 3). However, the Examiner relies on the combination of Jim and Gopal, and not on either one of them alone, as teaching the argued limitation. The argument that a single reference alone does not disclose all the recited claim limitations is not persuasive because non-obviousness cannot be established by attacking the references individually when the rejection is based on the teachings of a combination of references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Moreover, we agree with the Examiner that Gopal discloses hierarchal relationships between metadata objects and higher level objects, and further describes the examination and retrieval of objects that are impacted by an information change (Ans. 10, citing Gopal, paras. [0018], [0019], [0021], and [0024]).

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). We also will sustain the Examiner's rejection of dependent claims 2-5, which were not separately argued.

Independent claims 6 and 11 and dependent claims 7-10

Appellants argue that independent claims 6 and 11 are allowable for the same reasons as set forth with respect to claim 1 (App. Br. 6 and Reply Br. 3). We are not persuaded, for the reasons set forth above, that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Therefore, we will sustain the Examiner's rejection of claims 6 and 11 under 35 U.S.C. § 103(a). We also will sustain the Examiner's rejection of claims 7-10, which depend from claim 6 and were not separately argued.

Dependent claims 12-19

Dependent claims 12-15 and 16-19 depend from independent claims 1 and 6, respectively. Each of claims 12-19 further defines the criteria that are applied to the decision tree data structure to identify an object related to the changed object. For example, claim 12 recites that "the pre-determined criteria is that an identified object is related to the changed object if the identified object is below the changed object in the hierarchy of the decision tree data structure."

We are not persuaded by Appellants' argument that the Examiner erred in rejecting claims 12-19 under 35 U.S.C. § 103(a) because Jim fails to disclose or suggest the specific relationships recited in claims 12-19 (App. Br. 7 and Reply Br. 3-5). Instead, we agree with the Examiner that the features on which Appellants rely, i.e., the specific nature of the criteria, do not affect how the method of claim 1 is performed; nor do they affect the structure or operation of the claimed article of manufacture of claim 6 (Ans. 11-12). As such, these features constitute non-functional descriptive material that may not be relied on for patentability. *See In re Ngai,* 367 F.3d 1336, 1339 (Fed. Cir. 2004)*; cf. In re Gulack,* 703 F.2d 1381, 1385 (Fed.

Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). *See also Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative).

Appellants argue that the features are functional because "different changed objects and objects related to the changed objects may be identified based on different criteria, and different test plans may be retrieved based on the different changed objects and objects related to the changed objects, and finally, the different test plans may be performed" (Reply Br. 5). Yet the fact that different criteria may cause different objects to be affected and different test plans to be performed is not an indication that the specifics of the criteria affect the *way* the claimed method is performed or the structure and/or operation of the claimed article of manufacture; as presently claimed, these criteria have the characteristics of descriptive labels, rather than functions. As the Examiner explained:

> The method . . . and article of manufacture would perform the same way regardless of how, specifically, the related object is related to the changed object (i.e., where in relation to the changed object, that the related objects are situated or organized in the hierarchy). In other words, the related objects would still be identified, and the tests plans would still be identified, retrieved and performed on the related objects the same way, regardless of how the related object is related to the changed object. The Examiner asserts that the "criteria" appears to function as no more than the data identifying the related object.

(Ans. 12).

In view of the foregoing, we will sustain the Examiner's rejection of claims 12-19 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1-19 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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